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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/822,408	04/12/2004	Bryan E. Wilkins	9389-2	2887

7590

08/23/2004

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EXAMINER

TAWFIK, SAMEH

ART UNIT

PAPER NUMBER

3721

DATE MAILED: 08/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/822,408	WILKINS ET AL.	
	Examiner	Art Unit	
	Sameh H. Tawfik	3721	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) 22-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04/12/2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>04122004</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-21, drawn to a method for supplying a clip to a clip window associated with a closure attachment mechanism, classified in class 053, subclass 417.
- II. Claims 22-33, drawn to an apparatus for supplying a clip to a clip window associated with a closure attachment mechanism, classified in class 053, subclass 138.3.
- III. Claims 34-36, drawn to a computer program, classified in class 700.

The inventions are distinct, each from the other because of the following reasons:

Inventions Groups (I & II) and Group III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions as defined by the claims of Group III neither recites nor requires the inventions as defined by the claims of Groups (I & II).

Inventions Group I and Group II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process as claimed can be practiced by another materially different apparatus such as one without a curvilinear clip rail nor a clip pusher configured.

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Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

During a telephone conversation with Ms. Julie Richardson on 08/16/2004 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-21. Affirmation of this election must be made by applicant in replying to this Office action. Claims 22-36 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Drawings

Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.121(d)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted

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by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “second punch path with a second clip window” (claim 3, lines 3 and 4) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled “Replacement Sheet” in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it

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pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 3 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 3 refer to a second punch path with a second clip window, which was broadly described on the specification (page 5, 2nd paragraph) which was not clear how it works in view of the 1st punch path with a first clip window.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 6, and 11-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 recites the limitation "the first and second forcing steps" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 11 recites the limitation "the second forcing step" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 12 recites the limitation "the first forcing step" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 6-10, and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Chen et al. (5,586,424).

Chen discloses a method for supplying a clip to a clip window associated with a closure attachment mechanism adapted to allow a single clip or two clips to be controllably applied to a target tubular work piece in a closure zone in an automated manner comprising automatically forcing a plurality of clips (Fig. 1; via clips 14) to travel in a first predetermined clip travel path having a forward direction toward a first punch path (12) in a closure zone at a first point in time; automatically selectively retracting the plurality of clips so that the clips travel in a reverse direction along the first predetermined clip travel path away from the first punch path (column 3, lines 36 and 37; via arm 42 move upward while surface 68 insures that when arm 42 is moved in the upward direction opposite the desired direction the clips 14 will not move upwardly along the guide rail 22), note that it is inherent while the operation of surface 68 taking it location on the clips path and arm 42 moving upwardly clips will definitely move slightly on the upwardly direction; and then automatically forcing the plurality of clips to again travel in the forward direction along the first predetermined clip travel path at a second point in time (column 3, lines 51-55; via by moving arm 42 upwardly and then downwardly again for further moving the clips on the downwardly direction.

Regarding claim 2: automatically holding the plurality of clips (14) above a first clip window (24) associated with the first punch path (12) in the closure zone for a desired interval after said retracting step and before said second forcing step (via while arm 42 moves up and

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down), the interval associated with the number of target tubular workpieces (20) that pass through the closure zone without receiving a clip from the first punch path; and automatically intermittently attaching a clip to selected tubular workpieces that pass through the closure zone using clips advanced along the first clip path to the first punch path during the first and second forcing steps (Fig. 1).

Regarding claim 6: reciprocating a first punch (16) to travel along the first punch path (12) during “the first and second forcing steps” and the retracting step to selectively direct a clip (14) positioned in the clip window to wrap about an end portion of one tubular product in the first clip window during the first and second forcing steps (Fig. 1).

Regarding claim 7: wherein the first forcing step comprises pushing the clips to travel in a generally downward direction (Fig. 1; via arms 42), and wherein the retracting step comprises pulling the clips to travel in a generally upward direction (column 3, lines 36 and 37; via arm 42 move upward while surface 68 insures that when arm 42 is moved in the upward direction opposite the desired direction the clips 14 will not move upwardly along the guide rail 22), note that it is inherent while the operation of surface 68 taking it location on the clips path and arm 42 moving upwardly clips will slightly be pulled in the upwardly direction.

Regarding claim 8: further comprising feeding a spool (via 34) of attached clips (via stack 15) to travel along a generally downwardly extending static rail with a lateral portion that defines the first predetermined travel path so that the forward most portion of the spool of clips enters a clip window (24) to engage with a punch attachment mechanism (16) in the first punch path (12).

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Regarding claim 9: further comprising punching a clip in the clip window (24) to force the clip to wrap around an underlying target workpiece (Fig. 1).

Regarding claim 10: wherein the clips are metallic (column 2, line 38) with a discontinuous perimeter having generally open end portions that when attached to the tubular work product (Fig. 3; via U-shape clip 14) sealably enclose spaced apart end portions of the tubular work product (Figs. 1 and 3).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al. (5,586,424).

Chen does not disclose that the tubular workpieces are stuffed food product such as meat products. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Chen's method for supplying a clip to a clip window associated with a closure attachment mechanism by having the tubular workpieces are stuffed food product such as meat products, as a matter of engineering design choice, in order to pack meat products with using other teaching than heat sealing to avoid any damage to the food products and further the examiner takes an official notice that the mentioned tubular workpieces are stuffed food product such as meat products is old, well known, and available in the art.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al. (5,586,424) in view of Poteat et al. (5,495,701).

Chen does not disclose that a second plurality of clips to travel in a second predetermined clip travel path having a forward direction toward a second punch path with a second clip window. However, Poteat discloses a similar method for supplying a clip to a clip window associated with a closure attachment mechanism comprising a second plurality of clips to travel in a second predetermined clip travel path having a forward direction toward a second punch path with a second clip window (Fig. 4; via clips 6 on two different path pushed by two different pushers 14 and 16).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Chen's method by having a second plurality of clips to travel in a second predetermined clip travel path having a forward direction toward a second punch path with a second clip window, as suggested by Poteat, in order to close more than one package at the time to get more packages done in shorter period of time (column 1, lines 40-43).

Allowable Subject Matter

Claims 11-20 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Evans 5109648, Evans 5077955, Sinocchi 4708261, Niedecker 4571805, Velarde 4004339, and Klenz 3583056 disclose different method for supplying a clip to a clip window associated with a closure attachment mechanism.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sameh H. Tawfik whose telephone number is (703) 308-2809.

The examiner can normally be reached on Tuesday - Friday from 8:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on (703) 308-2187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sameh H. Tawfik
Patent Examiner
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A handwritten signature in black ink, consisting of a large, stylized 'S' followed by a horizontal line and a small upward stroke.

ST.